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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/446,521 | 03/03/2000 | YOSHIKI NAKAGAWA | 1581/00180 | 2445 |
| 30678 | 7590 | 06/25/2003 | | 29 |
| CONNOLLY BOVE LODGE & HUTZ LLP SUITE 800 1990 M STREET NW WASHINGTON, DC 20036-3425 | | | EXAMINER | |
| | | | MULLIS, JEFFREY C | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1711 | | |

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-----------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/446,521 | NAKAGAWA ET AL. |
| Examiner | Art Unit | |
| Jeffrey C. Mullis | 1711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 33-64 is/are pending in the application.
- 4a) Of the above claim(s) 36,54,55 and 57-61 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 33-35,37-53,56,63 and 64 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

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All previous rejections have been withdrawn.

Claims 33-64 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' method of forming a multiblock copolymer to the living radical polymerization or living cationic polymerization using a polymer I having two alkenyl groups per molecule is not enabled. Note in this regard that applicants' process is the same as that of Matyjaszewski et al. in that the living free radical polymerization utilizing a copper I halide and an unsaturated organic halo compound is described in scheme 5 of the patent as producing a multifunctional polymer not a polymer having two alkenyl groups. Note that applicants' own specification also discloses that their process proceeds by use of an unsaturated organic halo compound and a copper I halide catalyst as for instance in applicants' Example 2. Note for instance applicants' disclosure of alkenyl containing organic halides at page 14 lines 25 et seq. embraces structures including those utilized by patentees at column 21 lines 23-25 or for instance Example "d" of column 23 of patentees. It therefore does not reasonably appear that applicants would obtain the polymer I having only two alkenyl groups despite the fact that)

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Matyjaszewski et al. disclose the production of, at the very least, an uncontrolled number of alkenyl groups in their polymer. This process was therefore not properly described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention at the time the application was filed had possession of the claimed invention.

The specification as filed does not disclose a process in which a polymer having two alkenyl groups per molecule and a bifunctional initiator is used.

The specification as filed does not disclose broadly the process in which the polymer I having a number of alkenyl groups identical with the number of initiator groups is added to a living polymerization system or living cationic polymerization system but rather only discloses a single specific polymer using a specific process as set out on page 61 of applicants' specification. 264

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 63 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Matyjaszewski et al. (USP 5,789,487).

See the previous Office action at the paragraph bridging pages 2 and 3.

Applicants' arguments filed 3-28-03 have been fully considered but they are not deemed to be persuasive.

With regard to applicants' allegation of support for claim 63, the last formula on page 61 is not a generic structure encompassing any polymer but rather only a specific polymer, namely a polystyrene polybutyl acrylate block copolymer produced by living free radical polymerization and the full breadth of claim 63 is therefore not supported. With regard to claim 64, page 59 lines 8-9 and 17-19 merely disclose that the number of alkenyl groups at one end and at the other end were identical but does not disclose broadly that the number of alkenyl groups in the polymer is identical with the number of initiator groups.

With regard to Matyjaszewski, applicants' arguments have no pertinence to any of the limitations present in the claims argued by applicants. Thus claim 63 is not limited as to the number of alkenyl groups and is not limited as to production of linear multiblock copolymers.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time

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policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

June 23, 2003

Jeffrey Mullis
Primary Examiner
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